REMARKS

Claims 1-12 are pending in the application. Claims 1-12 stand rejected by the examiner. Assignee traverses the rejections of the claims. Claims 13-41 have been added herein.

New Claims

New claims 13-39 depend directly or indirectly from original claim 1. With respect to the new dependent claims 13-39, the table below sets forth at least one example of written description support for these newly presented claims. Other portions of the specification not specifically mentioned also provide support for the new claims.

Claim	Specification Citations (page:line numbers)
13	7:15-17; 14:18-20
14	7:15-17
15	14:24-25
16	14:18-20
17	7:14-17
18	7:14-17
19	7:17-18
20	7:17-18
21	14:14-15
22	7:17-18
23	7:15-17; 14:17-20

24	7:15-17
25	14:24-25
26	14:24-25
27	14:18-20
28	14:16-25
29	7:15-17
30	14:16-25
31	14:16-25
32	14:18-20
33	14:16-20
34	7:15-17
35	7:14-20; 14:16-20
36	7:18-20
37	14:22-24
38	14:22-24
39	14:22-24

New claims 40 and 41 are independent claims whose subject matter is based respectively upon pending claims 1 and 6.

Supplemental Oath/Declaration

The office action suggests that a Supplemental Oath/Declaration is needed in this application pursuant to 37 CFR 1.67(b). Applicants do not believe that such a document is required.

37 CFR 1.67(b) states that a supplemental oath/declaration must be filed "when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention **or** claims originally presented. . ." Thus, where the subject matter of the new or amended claim is "substantially embraced" in the original claims or the "statement of invention," then no supplemental oath is needed. Such is the case here.

Although the phrase "statement of invention" is not defined in the Patent Statute or the Code of Federal Regulations, the leading treatise on interpreting the Statute and the Regulations equates this phrase with the original disclosure, i.e., the entire specification. (*See*, Chisum on Patents, §11.02[1][c][iv], "On the other hand, if an amendment or alteration adds matter that clarifies the original disclosure or claims that are supported by that disclosure, no supplemental oath is required.") This same treatise cites to several cases that indicate that a supplemental oath is only required for amendments that constitute new matter. (*Austin v. Marco Dental Prods., Inc.*, 560 F.2d 996, 972 (9th Cir. 1977) ("Amendments not constituting new matter do not require the supplemental oath of the inventor."); *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 265 (2d. Cir. 1959), *cert. denied*, 361 U.S. 915 (1959) ("Many cases. . . have interpreted this Rule to mean that a supplemental oath is not necessary when the amended claims may fairly be derived from the original specifications."); and *Railroad Dynamics, Inc. v. A. Stucki Co.*,

579 F. Supp. 353, 370 (E.D. Pa. 1983, *aff'd*, 727 F.2d 1506 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 871 (1984) ("the question of whether the added claims constituted new matter for which a supplemental oath was required. . . depends solely on whether the claims are supported by the disclosure in the original application."))

The current set of claims is clearly substantially embraced by the specification as filed, as evidenced by the fact a new matter rejection/objection has not been lodged against these claims. Therefore, the claims are "substantially embraced" by the statement of invention, and thus a supplemental oath is not needed.

Claim Rejections - 35 U.S.C. § 112

Claims 1 and 6 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically, the office action maintains that applicant has not provided a detailed disclosure of "charging for advertising based on link traversals to the page." Assignee respectfully disagrees. As an example of claim 1, the first step of claim 1 determines a link traversal path, such as to assess whether the user went from an advertisement page to another page (e.g., to purchase a product). The second step of claim 1 then requires a charge for use of the advertising page in leading to that other page, such as, for example, by charging for the advertising in response to the number of sales that came as a result of the user encountering the advertising page. This example of charging for the advertising in response to the number of sales is disclosed on page 15, lines 4-6 of assignee's

specification and provides an enabling disclosure for the charging step of claim 1. The fact that this passage from assignee's specification comprises an enabling disclosure for the charging step of claim 1 is further supported in that claim 3 specifically recites this example contained in this passage and was not rejected for lack of enablement. In other words, if claim 3's specific example of the "charging" step of claim 1 is enabled by the aforementioned passage, then the more general "charging" step of claim 1 must be enabled by the same passage that enabled the more detailed "charging" limitation of claim 3. Accordingly this rejection for claim 1 should be removed. Furthermore in view of the discussion above, claim 6's recitation of "charging" is also enabled and the instant rejection should be removed.

The office action also rejected claims 4-5 and 9-11 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically, the office action maintains that applicant has not provided a detailed disclosure of "measuring the number of sales or transactions resulting from link traversals." Assignee respectfully disagrees. In addition to the number of passages in assignee's specification that enable this limitation (and which were pointed out in previous responses), the commonly assigned U.S. Patent No. 5,715,314 provides additional disclosure that is related to measurement of sales within a computer network sales system. (This patent was expressly incorporated by reference at page 3, line 7 of assignee's specification.) For example, U.S. Patent No. 5,715,314 discloses a settlement database which records details of purchase transactions. The settlement database and its contents are further described as follows:

> Payment computer 16 has access to a settlement database 22 in which payment computer 16 can record details of purchase transactions. [...]
>
> With reference to FIG. 2, a purchase transaction begins when a user at buyer computer 12 requests advertisements (step 24) and buyer computer 12 accordingly sends an advertising document URL (universal resource locator) to merchant computer 14 (step 26). The merchant computer fetches an advertising document from the advertising document database (step 28) and sends it to the buyer computer (step 30). An example of an advertising document is shown in FIG. 5. Details of URLs and how they are used are found in the microfiche Appendix G.
>
> The user browses through the advertising document and eventually requests a product (step 32). This results in the buyer computer sending payment URL A to the payment computer (step 34). Payment URL A includes a product identifier that represents the product the user wishes to buy, a domain identifier that represents a domain of products to which the desired product belongs, a payment amount that represents the price of the product, a merchant computer identifier that represents merchant computer 14, a merchant account identifier that represents the particular merchant account to be credited with the payment amount, a duration time that represents the length of time for which access to the product is to be granted to the user after completion of the purchase transaction, an expiration time that represents a deadline beyond which this particular payment URL cannot be used, a buyer network address, and a payment URL authenticator that is a digital signature based on a cryptographic key. The payment URL authenticator is a hash of other information in the payment URL, the hash being defined by a key shared by the merchant and the operator of the payment computer.
>
> (See U.S. Patent No. 5,715,314 at col. 5, lines 5-47.)

Other passages from this patent also show tracking of purchases, such as the discussion of generating smart statements (e.g., see U.S. Patent No. 5,715,314 at col. 8, lines 33-37). The disclosure of assignee's specification alone provides enablement for the instant claims, but further non-limiting enabling examples of the instant claims are also provided when viewing the disclosure of assignee's specification in combination with this incorporated patent. Because claims 4-5 and 9-11 are enabled, the rejection should be removed and the claims proceed to issuance.

Claim Rejections - 35 U.S.C. §§ 102 and 103

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Gary Welz, The Media Business on the WWW: The Price and Value of Advertising on the WWW (hereinafter referred to as "Welz"). Claims 2 and 4-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Welz in view of Wecker, USPN 5,806,077 (hereinafter referred to as "Wecker"). Claims 6-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wecker in view of Welz. These rejections are traversed.

With respect to the Welz reference, assignee respectfully asserts that Welz cannot be considered prior art for the purposes of the rejection until a definitive publication date or retrieval date is established. The Welz reference is asserted to be published in connection with the Electronic Proceedings of the Second World Wide Web Conference '94: Mosaic and the Web. While the proceedings are identified as having taken place in 1994, the Conference Tracks indicates that "[t]his should be considered a work in progress until shortly after the Conference when the last of the papers are submitted and the final corrections are made" (see http://archive.ncsa.uiuc.edu/SDG/IT94/Proceeings; see Exhibit A). There is no indication how long after the Conference papers were being submitted, from what sources the papers were obtained, and how long it took for them to publish the documents. In fact, the file contains no indication of a publication date or retrieval date. Under MPEP 2128, if the publication does note include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. § 102(a) or (b). Until such time as a definitive publication date or retrieval date can be established, assignee submits that the § 102 rejection is improper and should be withdrawn.

Assignee notes that the office action on page 11 states that the examiner was unable to duplicate applicant's actions mentioned in the previous office action response regarding the Welz reference and was unable to discover a statement referring to the "Proceedings of the Second World Wide Web Conference '94." In response, assignee has attached to this amendment (at Exhibit A) a web page bearing the title "Electronic Proceedings of the Second World Wide Web Conference '94: Mosaic and the Web" and which provides: "This should be considered a work in progress until shortly after the Conference when the last of the papers are submitted and the final corrections are made." Because of such additional information, assignee respectfully submits that the Welz reference cannot be considered prior art and the rejections involving the Welz reference be withdrawn.

The office action also rejected claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Catledge et al., Characterizing Browsing Strategies in the World-Wide Web (hereinafter referred to as "Catledge") in view of Bob Novick, The Clickstream (hereinafter referred to as "Novick").

Attached to this Amendment at Exhibit B is a Declaration of Prior Invention Under 37 C.F.R. § 1.131, which establishes that the subject matter of claims 1-11 was actually reduced to practice prior to March, 1995, the earliest effective date of the Catledge and Novick references. Thus, the rejections over Catledge and/or Novick that relate to these claims must be withdrawn.

With respect to claim 12, Novick in combination with Catledge has been cited by the office action as disclosing the limitations of claim 12. Assignee respectfully disagrees since Novick (whether considered alone or in combination with the other cited

references) does not disclose the limitations of claim 12. Claim 12 depends from claim 6 and recites filtering transaction logs from at least one server for a particular user to produce an access history. In claim 12, the filtered transaction logs are for use in charging for advertising based on the number of link traversals to the second document. The office action cites Novick for teaching the feature of charging for advertising based on the number of link traversals to the second document. However Novick only generally mentions that advertisers are advertising on the Web, and that in the future we may hear about "the cost per thousand clicks." This general recitation in Novick does not disclose such limitations of claim 12, and thus the rejection for claim 12 should be removed.

Information Disclosure Statement Submissions

Assignee respectfully requests that the examiner initial the information disclosure statements that were submitted to the United States Patent Office on the following dates:

- March 24, 2005
- November 17, 2005
- June 6, 2006 (which IDS was submitted after the issuance of this office action)
- July 20, 2006 (which IDS was submitted after the issuance of this office action)

For convenience, assignee has attached at Exhibit C a copy of these information disclosure statements for initialing by the examiner.

CONCLUSION

For the foregoing reasons, assignee respectfully submits that claims 1-41 are allowable. Therefore, the examiner is respectfully requested to pass this case to issue.

Respectfully submitted,

By: _____

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